

REMARKS

Claims 1, 2, and 7 has been amended. Claim 3 has been canceled. New claims 12-16 have been newly added. Support may be found in the claims, as originally filed.

Claims 1-11 have been rejected under 35 U.S.C § 112, second paragraph, as being indefinite. The examiner maintains the position that it is unclear what is meant by a "rosin derived alcohol" or a "rosin derived mono-ol." The examiner urges that it is unclear whether such recitation refers to an alcohol functional compound incorporating rosin moieties, a rosin incorporating alcohol moieties, a product obtained by reacting a rosin with an alcohol or a mono-ol or some other structure. The argues that the name, structure or method of preparation of the rosin derived alcohol or rosin derived mono-ol should be clearly set forth in the claims.

Applicant disagrees with the examiners position. One of ordinary skill in the art would interpret a "rosin derived alcohol" to be an alcohol derived from a rosin, e.g., by converting an acid moiety to a hydroxyl (alcohol) group.

As disclosed on page 5 of applicant's specification, "[s]uitable rosin derived alcohols include hydrogenated rosin, available from Eastman (previously Hercules) under the tradename Abitol E." Chemically, ABITOL-E (hydroabietyl alcohol) is a monohydric alcohol derived from rosin acids that have been hydrogenated to reduce unsaturation. See, *Handbook of Adhesives*, Third Edition, Irving Skeist, Editor, pp. 563. *Hercules® Rosins, Resources for the New Millennium*, Table III, pp. 4-5. Also attached is web site literature (EASTMAN and ChemFinder showing that ABOTOL-E (hydroabietyl alcohol is a monohydric alcohol derived from hydrogenated rosin.

Claims 1, 2, 4-6 and 8-10 are rejected under 35 U.S.C § 102 (b) as being anticipated by WO 01/29134. Claims 1-6 and 8-10 are rejected under 35 U.S.C § 102 (b) as being anticipated by each of Erickson (U.S. Patent No. 5,382,604 or 5,389,701). Claims 1-6 and 8-11 are rejected under 35 U.S.C § 102 (b) as anticipated by Dillman et al. (U.S. Patent No. 5,536,772). In applying the Section 102 rejection, the examiner urges that the disclosure of

Udipi et al. (U.S. Patent No. 4,135,037) is incorporated within the disclosure of Dillman, and refers to col. 8, line 56 to col. 9, line 2, in support thereof.

Claims 1-6 and 8-11 are rejected under 35 U.S.C § 103 (a) as anticipated by Dillman et al. (U.S. Patent No. 5,536,772) in view of Udipi et al. (U.S. Patent No. 4,135,037).

All claims are directed to a radiation curable adhesive, a required component of which is a rosin derived alcohol. As acknowledged by the examiner, WO 01/29134 fails to disclose adhesive compositions that comprise a rosin derived alcohol. As such, WO 01/29134 fails to anticipate the claimed invention.

None of the Erickson '604, Erickson '701, or Dillman references discloses radiation curable adhesives comprising a rosin derived alcohol so as to anticipate the claimed invention. Udipi also fails to disclose the use of a rosin derived alcohols, and as such fails to cure the defect of Dillman so as to render the claimed invention obvious.

Rosin derived alcohols are not, as urged by the examiner, what Udipi and Dillman are referring to. They are referring to esters from rosin (an acid) and alcohol. See Udipi col. 2, line 64, which recites that useful tackifiers are "esters of rosin and the modified rosins with alcohols".

Moreover, Dillman teaches away from using the tackifying resins of Udipi in radiation crosslinked compositions. Dillman, in the paragraph bridging cols. 8 and 9, disclose:

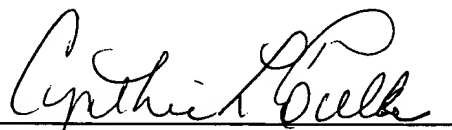
In the radiation crosslinked compositions of the present invention, including adhesives, coatings and sealants, it is necessary to add an adhesion promoting or tackifying resin that is compatible with the polymer. *The prior art, as exemplified by U.S. Pat. 4, 135,037, teach that hydrogenated rosins, esters of rosins and other rosin materials are very compatible with epoxidized diene polymers.* This indeed appears to be true. However, the prior art evidently did not attempt to radiation crosslink the compositions described including epoxidized diene polymers and rosin tackifying resins. *The Applicants herein have found that rosin materials interfere with the cure of the composition and thus were not well suited for use in the radiation crosslinked compositions of the present invention.* (emphasis added)

Thus, Dillman teaches that the tackifiers of Udipi kill the reaction. Applicants note that esters are known to slow cationic polymerization.

Applicants are not claiming the use of rosin esters as a tackifying agent. The rosin derived alcohols used as a reactant in the practice of applicant's claimed invention is not anticipated by, or obvious over the prior art of record. Withdrawal is requested.

Early and favorable action is solicited.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Cynthia L. Foulke", written over a horizontal line.

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